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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,274	04/08/2004	Tracy Marie Kilmartin	03248-P0001B SPM/HJP	8596
24126	7590	05/17/2005	EXAMINER	
ST. ONGE STEWARD JOHNSTON & REENS, LLC			GERRITY, STEPHEN FRANCIS	
986 BEDFORD STREET			ART UNIT	
STAMFORD, CT 06905-5619			PAPER NUMBER	

3721

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,274	<b>Applicant(s)</b> KILMARTIN, TRACY MARIE	
	<b>Examiner</b> Stephen F. Gerrity	<b>Art Unit</b> 3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper.No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/9/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION**

***Information Disclosure Statement***

1. Receipt is acknowledged of an Information Disclosure Statement, filed 9 September 2004, which has been placed of record in the file. An initialed, signed and dated copy of the PTO-1449 form is attached to this Office action.

***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings filed 8 April 2004 are informal in quality. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Continuing Data Should Be Updated***

3. Applicant is respectfully requested to carefully review all continuing data for accuracy and completeness, and the status of each parent application should be updated where appropriate.

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***Specification***

4. The abstract of the disclosure is objected to because of the use of legal phraseology ("means" in line 2). Correction is required. See MPEP § 608.01(b).

***Claim Objections***

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 16 (second occurrence) has been renumbered as claim 18.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 10 recites in lines 7-11, "employees of said manufacturers, distributors, or retailers mounting said bottle dividers to bottles of wine or liquor sold by said manufacturers, distributors, or retailers, either at the time of packaging individual bottles for taking by a purchaser of such bottles of wine or liquor or to bottles of wine or liquor held in inventory but not for display". The claim is considered to be non-enabled by the written description (including the drawings) because the written description does not describe to one skilled in the art how to make and use the claimed subject matter. The issue at hand is the use of the language "mounting said bottle dividers to bottles for taking ..." and the use of the language "... to bottles ... held in inventory but not for display". The written description at paragraphs [0007] and [0014] set forth that employees will mount the bottle dividers to bottles, but the written description does not go on to further describe how this is done. There is no disclosure set forth of any structure that would permit the bottle dividers to be mounted to the bottles. A person of ordinary skill in the art is not

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appraised of how to make and use the claimed invention set forth in claims 10-18 based on the written description (including the drawings). Furthermore, it is unclear if the written description is simply in error typographically or editorially. Is the description set forth in paragraphs [0007] and [0014] supposed to recite "mounting the bottle dividers between bottles" instead of "mounting the bottle dividers to bottles"?

Additionally, the subject matter of claim 14 does not make sense within the context of the subject matter set forth in claim 10. It is not adequately set forth in the written description how the sheets (the dividers) are mounted to the bottles (as required by claim 10) and also mounted to each other as now required by claim 14.

Claims 10-18 will not be further considered further in this Office action for purposes of determining patentability over the prior art.

Applicant is respectfully requested to review and revise the written description and/or the subject matter of claims 10-18 as appropriate, and/or provide clarification in response to this Office action. Applicant is reminded that no new matter may be entered into the disclosure and/or claims.

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Finch (GB 2,213,464).

The Finch reference discloses a method of advertising (page 2, lines 18 and 19), comprising the steps of: fabricating bottle packaging dividers (page 2, lines 29 and 30) each having an exterior face (page 2, lines 18 and 19); imprinting advertising information on the exterior faces of said bottle packaging dividers (page 2, lines 18 and 19); distributing said bottle dividers to retail outlets licensed to sell bottles of wine or liquor (page 1, lines 3-10 and page 2, lines 21-23); employees of said retail outlets placing said bottle packaging dividers between bottles of wine or liquor sold by said retail outlets, at the time of packaging individual bottles for taking by a purchaser of such bottles of wine or liquor (page 1, lines 3-10). Regarding claim 2, the Finch reference discloses that the dividers comprise a cushioning material. Regarding claim 3, the

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Finch reference discloses that the cushioning material comprises a plastic material.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 4,869,599) in view of Goldman (US 5,833,056) and Finch (GB 2,213,464).

The Allen reference discloses a method of supporting drink cups or bottles (col. 3, lines 15 and 16) in a bag or carton (col. 3, lines 24-26) comprising fabricating bottle packaging dividers each having an exterior face (paragraph bridging columns 4 and 5); distributing the bottle dividers to retail outlets (inherent in that the dividers are provided to be inserted in a bag or carton); employees of the retail outlets placing said bottle packaging dividers between bottles, at the time of packaging individual bottles for taking by a purchaser of such bottles (col. 3, lines 14-36).



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The Allen reference meets all of applicant's claimed subject matter with the exception of imprinting advertising information on the exterior faces of the bottle packaging dividers, that the dividers are distributed to retail outlets licensed to sell bottles of wine or liquor, and that the dividers are placed between bottles of wine or liquor sold by said retail outlets.

The Goldman reference (see figures) as well as the Finch reference (as previously set forth above) each disclose that information or advertising indicia is imprinted on the exterior face of the dividers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have imprinted advertising on the dividers, as suggested by Goldman or Finch, for the benefit of providing information to a customer or potential customer.

The Finch reference discloses that the dividers disclosed therein are inherently distributed to retail outlets licensed to sell wine for the expressed use in protecting bottles of wine or the like (page 1) sold thereby. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Allen method by including distributing the Allen dividers to retail outlets licensed to

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sell bottles of wine for use in being placed between the bottles of wine, as taught by Finch, for the purpose of protecting the bottles of wine from being broken.

Regarding claim 2, the Allen bottle packaging dividers are arguably inherently a cushioning material. Assuming such is not the case, the Finch reference teaches that the dividers should comprise cushioning material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have further modified the Allen bottle dividers to have been formed from cushioning material, as taught by Finch, for the common sense idea of protecting the bottles of wine.

Regarding claim 3, the Allen bottle dividers are disclosed as being made from chipboard and thus Allen does not teach the cushioning material being corrugated paper or plastic material. The Finch reference discloses that the dividers are made from plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have further modified the Allen bottle dividers to have been made from plastic material, as suggested by Finch, as plastic material is cheap and readily available.

Regarding claim 4, the Allen reference discloses that each bottle packaging divider comprises at least two sheets (18, 19),

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each sheet having a slit cut therein (57, 58), and the sheets are mounted to each other by fitting together slits of the two sheets (figures 3 and 4).

Regarding claim 5, the Allen reference discloses that the sheets are sized to fit within a shopping bag of a predetermined size (see column 3).

Regarding claim 6, the Allen reference discloses that the sheets are sized to fit within a carton of a predetermined size (see column 3).

Regarding claim 7, the Allen reference discloses that the sheets are mounted to each other by the employees of said retail outlets (inherently done based on the disclosure in col. 3).

Regarding claim 8, the Allen reference discloses that there are two sheets (18, 19).

Regarding claim 9, the modified Allen method does not disclose that the two sheets are both imprinted with advertising information. However, both the Goldman and Finch references disclose imprinting information or advertising indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Allen method by having the two sheets both imprinted with advertising information, as suggested by Goldman and Finch, as such would

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have involved a mere duplication of elements of the device used in the method, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### **Conclusion**


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show methods of packaging and dividers used in packaging. All are cited as being of interest and to show the state of the prior art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is (571) 272-4460. The examiner can normally be reached on Monday - Friday from 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Stephen F. Gerrity**  
**Primary Examiner**  
**Art Unit 3721**

29 April 2005